SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

No. 786

WILCOX MANUFACTURING COMPANY, *Petitioner*

v.

JEFFREY GALION MANUFACTURING COMPANY, *Respondent*

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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Petitioner respectfully prays that a Writ of Certiorari issue to review the decree or judgment of the Court of Appeals for the Fourth Circuit in consolidated Appeals Nos. 11963 and 11964, dated July 18, 1968, —— F. 2d ——, 158 USPQ 510. Petition for rehearing was denied September 6, 1968.

OPINIONS OF THE COURTS BELOW

The opinion of the United States Court of Appeals for the Fourth Circuit, dated July 18, 1968, is reported at — F. 2d —, 158 USPQ 510. A copy of this opinion is appended to this petition, (Appendix page 1a).

The opinion of the District Court for the Northern District of West Virginia (Judge John A. Field) is reported at 278 F. Supp. 34, 157 USPQ 82. A copy is attached (Appendix page 9a).

JURISDICTION

This Court has jurisdiction to issue the writ now requested under the provisions of Title 28, United States Code, Section 1254, (1).

The judgment or decree of the Court below, review of which is sought, became final for purposes of this review on Sept. 6, 1968, the date of the Order denying a timely petition for rehearing of the judgment or decree of July 18, 1968.

Appeal No. 11964 arose from a judgment on a civil action filed in the District Court for the Northern District of West Virginia under the Declaratory Judgments Act, Title 28, United States Code, Sections 2201 and 2202; and Title 28, United States Code, Sections 1332 and 1338, as well as Title 35, United States Code, Chapters 28 and 29. Jurisdiction of the United States Court of Appeals of the Fourth Circuit was conferred by Title 28, United States Code, Section 1291.

QUESTION PRESENTED FOR REVIEW

In a declaratory judgment action brought by an old established company in an industry, against the patent of a new and infant competitor, did it subvert the constitutional purpose of the patent laws for the Court below to "vitiate" the patent "on its face" on a technical point of Patent Office practice which had already been considered and waived by the Patent Office before issuing the patent, without the Court even weighing the worth of the invention actually claimed in the new competitor's patent, as to its lack of obviousness or anticipation or its commercial success, when there was uncontroverted evidence that the invention had made possible the creation of a new industrial enterprise in an economically depressed region of the United States?

CONSTITUTIONAL AND STATUTORY PROVISIONS

The case involved Article 1, Section 8 of the Constitution of the United States reading:

> "Art. 1, Sec. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

Also involved is Title 35, United States Code, Section 112 which is set forth in the appendix of this petition, at page 28a.

STATEMENT OF THE CASE

Respondent, Jeffrey-Galion Manufacturing Company filed a Declaratory Judgment action against the Wilcox patent 3,026,098 on May 7, 1962, shortly after the patent had issued on March 20, 1962.

Prior to the filing of this Declaratory Judgment action, Wilcox had brought an action for patent infringe-

ment against Eastern Gas & Fuel Associates, a large coal mining operator. Respondent Jeffrey had then arranged with Eastern to take over complete control of the defense of the civil action which had been filed against Eastern, and then filed the Declaratory Judgment action against Petitioner Wilcox asking for a declaration of non-infringement and invalidity of the Wilcox patents.

The two civil actions were consolidated and tried together in June of 1965.

More than two years later, July 26, 1967, the United States District Court (Judge Field) handed down its opinion holding both patents invalid and not infringed.

Petitioner Wilcox appealed and the Court of Appeals for the Fourth Circuit affirmed in an opinion dated July 18, 1968.

ARGUMENT

The large coal mine operating companies customarily mined the richer seams of coal of greater height and simply left the coal in the poorer or shorter seams in the ground, because the established manufacturers of mining machinery could not make machines which would mine the leaner coal seams of shorter height. The Wilcox invention benefited the smaller mining operators who were *then able* to mine the shorter seams, *and survive.*

The Court of Appeals chose to summarily "vitiate" the Wilcox patent 3,026,098 on its face on a highly technical point of Patent Office practice called file wrapper estoppel, while refusing to weigh or consider the merits of the invention as presented in a carefully prepared record made largely out of the mouths of

the Jeffrey officials and from unchallenged documents out of the plaintiff Jeffrey's own files. This record established the presence of invention, lack of obviousness or anticipation by the prior art, and great commercial success *which had been a boon to small operators mining coal in the depressed Appalachian coal regions of West Virginia, Pennsylvania, and Tennessee.*

This is not the usual patent case involving the rival activities of established competitors. Defendant Wilcox was an unwelcome infant innovator trying to enter an old established industry. Plaintiff Jeffrey deliberately copied defendant's patented miner for the purpose of preempting the market the new invention had created.

There was a deliberate plan to appropriate the innovator's invention and to destroy the validity of his patent rights.

The plan to appropriate the Wilcox invention and the market it had created, is apparent from unchallenged documents from Jeffrey's files, written by its own officials. The following is representative, from a 1958 report written to Jeffrey's Vice President Wilson:

> "The first phase of our investigation into the performance and potential of the mining machine manufactured by the Wilcox Manufacturing Company and known as the Wilcox miner has been completed * * *.
>
> The customer would be very happy with a tonnage of 100 to 120 tons per shift per machine. They continue to mention the fact that the use of the Wilcox miner permits them to mine at an economical figure a quality of coal *that otherwise would be left in the ground* until further developments in mining technique are made * * *.

> If, as a result of this commercial survey, we could show a potential of 50 machines in the next three years, I would say that we have a very worthwhile and profitable venture. The spare parts business is bound to be good on this machine, plus the fact that *with each Wilcox miner* we open up a potential for chain conveyors." (Ex. W 19; WA 112-117)*

As a result of the decree successfully urged by plaintiff Jeffrey on the Court below, it will have been successful in its litigation plan to destroy the patent rights on which Wilcox's new enterprise depends, after having successfully preempted the market created by Wilcox's invention.

The Wilcox apparatus patent 3,026,098 issued March 20, 1962. On May 7, 1962, plaintiff Jeffrey Galion Mfg. Co. filed a Declaratory Judgment action against the Wilcox patent, asking that it be declared invalid.

Prior to the filing of this Declaratory Judgment action, Wilcox had sued one of the largest coal mining operators, Eastern Gas & Fuel Associates, for patent infringement, and Jeffrey had then arranged with Eastern to take over complete control of the defense of this suit, and had agreed to also file the Declaratory Judgment action against Wilcox, on condition that Eastern would "refuse to negotiate any settlement with Wilcox" (WA 153-155).

The old and established Jeffrey company filed the Declaratory Judgment action against the Wilcox patent because its management viewed with *amazement*

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* The printed record below was in two volumes. "WA" refers to the Wilcox Appendix volume which has a white cover, and "JA" refers to the Jeffrey Appendix volume which has a blue cover. Emphasis is ours throughout unless otherwise indicated.

and even *alarm,* the success of the unwelcome competitor with its new miner. Unchallenged documents from Jeffrey's files, written by its own officials, stated:

> "Within the last two months the activity in Wilcox miners is *amazing* * * * considering the tight purse strings that operators are maintaining on capital expenditures.
>
> In addition, the interest in this machine by *small operators* (250-300 tons daily) *is increasing tremendously* * * *. Right now is the greatest activity in the Wilcox miners and the transactions are being completed *at an alarming rate.* (Ex. W-77; WA-180, 181).

Arnold Wilcox, an elderly man with a fourth grade education, created a new branch from an old industry.

The patented miner was invented by Arnold Wilcox, an elderly man from Raleigh, West Virginia who had enjoyed only the benefit of a fourth grade education (WA-526, 538). Much of his adult life was spent as a miner underground in the coal mines of West Virginia (WA-527,529).

The first of the machines of Mr. Wilcox's patent were made with crude tools in an abandoned machine shop near Raleigh, West Virginia, where he had only eight employees to help him (WA-419-421). The infant Wilcox company was built and has survived at Raleigh because of Arnold Wilcox's invention.

By the time of the trial in 1965, the infant Wilcox company had sold as many as 216 of the machines of Arnold Wilcox's invention (WA-426). These figures represent the creation of a new industry, when it is considered that the price of each machine exceeds

$50,000 (WA-426), and that these machines, for the first time, made possible the economical underground mining of low seams of coal of height on the order of only 38 inches or lower.

The plaintiff Jeffrey company is a giant of the coal mining machinery industry that has been engaged in developing and marketing mining machinery since as early as 1874 (WA-369). The Jeffrey company deliberately copied the Wilcox miner. There is no question here about which party was the first inventor of the new machine.

Jeffrey, a giant of the industry calculatedly made its miner in the image of the new Wilcox. These miners revolutionized the industry.

It was admitted that by the time of the trial, plaintiff Jeffrey had sold at least 60 or 70 of these Wilcox type miners (WA-512). Unquestionably, these sales *have multiplied* since the trial [1] in June of 1965.

In the words of the Court of Appeals "The machine accused here and known as the Jeffrey unit undoubtedly was *calculatedly made in the image of the Wilcox miner* but without the ingredient of reciprocation.[2] "

The District Court had found:

> "First of all, the record clearly shows that Jeffrey, influenced by the success of the Wilcox

[1] ***More than two years elapsed after the trial*** before the District Court rendered its decision declaring the Wilcox patent 3,026,098 invalid.

[2] This reciprocation feature is the basis of the technicality successfully urged on the Court by the plaintiff to vitiate the patent. The claims of the patent which define the patented invention are ***not*** limited to this feature.

> machine, *studiously copied* the Wilcox product and placed on the market the Jeffrey 100-L which was to a large degree *a duplication* of the machine being produced and sold by Wilcox." (WA-40)

The Wilcox miner, and its duplication, the accused Jeffrey 100-L, revolutionized the coal mining industry. Upon introduction of the Wilcox machine, it was possible for the first time to mine underground low seams of coal (38 inches or lower in height) *which would otherwise have been left in the ground.* Although not considered by the Court of Appeals, the invention caused production of low seam coal to soar upward in the Appalachian areas while mining costs were reduced.

Although the Court of Appeals did not choose to weigh the evidence offered on the point,[3] the invention revitalized low seam coal mining operations in the depressed Appalachian areas, *enabling small operators to survive.* An unchallenged report of 1962 from Jeffrey's files, referred to the 100-L miner which the Court of Appeals said "was calculatedly made in the image of the Wilcox miner" (Ex. W-15), (WA-103) as follows:

> "The future prospects for this type miner are *tremendous.* With the Type 100-L Miner, coal companies are planning to mine coal seam areas of their mines that *heretofore could only be uneconomically mined.* The coal companies having

[3] The Court of Appeals stated: "Inasmuch as we vitiate the patent on its face in the light of its representation to the Patent Office and the District Court, we have no occasion to put it to the obviousness tests of Graham v. John Deere Co., 383 U.S. 1, 17 (1965). Nor need we weigh the defenses of anticipation or prior art. For the same reasons, commercial success and the other 'secondary considerations' are not presently pertinent. Id. 17. We do refer to Graham, however, to justify our use of the patent's history. Id. 33". (Appendix p. 7a)

thin seam operations are located in areas which generally coincide with the Appalachian Mountain Range extending from Central Pennsylvania down through Middle Tennessee.

In mines where the Miners are now being used, production has *soared upwards* and consequently mining *costs have been reduced.* * * *

In addition, the 100-L Miner is obtaining the enviable name of 'The Poor Man's Miner'; *now small operators with limited capital can apply progressive continuous mining methods* with lower initial costs and less labor personnel.

Other changes will be made in the design of the Miner as the conditions warrant, but the basic design has been quickly accepted by the mining industry." (Ex. W-15), (WA-103).

The Jeffrey officials were given every opportunity to explain away the cruel import of the reports obtained from the company's files. Not one of them could do so. (Wilson WA-332-335; Knode WA-387, 388; Montgomery WA-519, 521, 524).

Although the Court of Appeals said "We have no occasion * * * to weigh the defenses of anticipation or prior art," it is noteworthy that the uniqueness of the Wilcox miner and the complete absence of any significant prior art, *was established beyond any question.* These excerpts from testimony of Jeffrey's Vice-President Wilson, and expert Frantz, establish this:

"Q. Can you name any other miners, machines other than the 100-A, 100-L and the Wilcox miner that was on the market *within your experience* that were made in accordance with the principles that we have discussed, the adjustable augers [horizontally] spaced, and so forth.

A. No.

Q. And your experience in the industry dates back until when, sir?

A. In 1922. (Testimony of Wilson, WA-362).

* * * * * *

Q. Now, yesterday, Mr. Frantz, you testified with respect to a number of patents. Do you recall?

A. Yes, sir.

Q. And of those patents which you testified on yesterday, would you tell the Court if you ever saw a machine either in operation or on the floor somewhere as described in those patents?

A. I am not sure that I have, sir." (WA-446)

The learned expert Frantz with many years of experience in the industry, then admitted that the machines of each of the prior art patents, had not even appeared in the industry, to the best of his knowledge (WA-446, 447). Thus, from the standpoint of practical underground coal mining, the Wilcox invention was revolutionary.

'The Court below, erroneously vitiated the Wilcox patent without evaluating the worth of the invention defined in its claims.

While not referred to by the Court below, and this is clear error in view of previous opinions and decisions of this Court, Wilcox *did* claim the invention of his miner *without* the reciprocation feature as a combination of two augers horizontally spaced and vertically adjustable, when he filed his first or original patent application, Serial No. 449,851, on August 16, 1954. See original claim 1 (WA-79-80). As stated in *United States* v. *Adams,* 383 U.S. 39, 49 (1966), "this feature was not the afterthought of an astute patent trial lawyer."

These original broad claims on the combination *without* the reciprocation feature were initially rejected and then cancelled by Wilcox, but were reinstated by an amendment filed July 1, 1959. See claim 17 (JA-206b).

After further rejection, these claims without the reciprocation feature were presented in the Wilcox divisional application Serial No. 108,371, filed May 8, 1961 from which they issued in the Wilcox patent 3,026,098 on March 20, 1962. This is the Wilcox patent against which the Declaratory Judgment was brought. This Court has stated, in upholding the patent in *Smith* v. *Snow,* 294 U.S. 1, 16 (1935):

> It is of no moment that in the course of the proceedings in the Patent Office the rejection of narrow claims was followed by the allowance of the broader claim 1.

The point of Patent Office practice on which the Wilcox patent was "vitiated", i.e., that Wilcox was estopped to reinstate the combination claims without the reciprocation feature, was first asserted and then withdrawn or *waived* by the Patent Office. This is the exact point which was in issue before this Court in *Overland Motor Co.* v. *Packard Motor Car Co.,* 274 U.S. 417 (1927). This Court held the patent with such claims to be valid in the *Overland* v. *Packard* case. A "file wrapper defense" was also rejected in *Smith* v. *Snow,* 294 U.S. 1.

The Court below "vitiated" the Wilcox patent without evaluating the worth of *the invention of its claims,* which were not limited to the reciprocation feature disclosed in the specification, erroneously relying on file wrapper estoppel. This decision is also in direct

conflict with *Smith* v. *Snow,* 294 U.S. 1, 6, 11, and 16 (1935). As there stated, 294 U.S. at 14:

> ". . . it is plain from what has been said that the *character of the patent* and its commercial and practical success are such as to entitle the inventor to broad claims and to a liberal construction of those which he has made."

And at 294 U.S. 11:

> "We may take it that, as the statute requires, the specifications just detailed show a way of using the inventor's method, and that he conceived that particular way described was the best one. But he is not confined to that particular mode of use since the claims of the patent, not its specifications, measure the invention."

The Court below did not heed the commands of *Graham* v. *John Deere Co.,* 383 U.S. 1 (1965), to first consider the invention as a whole, to measure that invention against the prior art, and to determine the true merit and breadth of the patent. Rather, the Court of Appeals, considering those commands "not presently pertinent" judged the patent only against its own specification, thus committing a serious misconstruction of the patent and a misapplication of this Court's recent decisions in *Graham* and *Adams,* supra.

The practical effect is that petitioner has been denied a full hearing contrary to fundamental principles of due process. Unlike *United States* v. *Adams,* supra, here the dominant company in an industry has successfully destroyed a patent on a very meritorious invention. A pioneer inventor is entitled to cover devices which depart structurally from the specific embodiment described in the specification. *Smith* v. *Snow,* supra.

CONCLUSION

The Court below decided a federal question in a way which is in conflict with applicable decisions of this Court. In so doing, the constitutional purpose of the patent laws was subverted by vitiating a new competitor's patent on its face, when that competitor was using the patent as was intended by the Constitution, in an attempt to enter and compete in an old and established industry.

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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APPENDIX

UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT

No. 11,963.

WILCOX MANUFACTURING COMPANY, *Appellant,*

v.

EASTERN GAS AND FUEL ASSOCIATES, *Appellee.*

No. 11,964.

JEFFREY GALION MANUFACTURING COMPANY, *Appellant,*

v.

WILCOX MANUFACTURING COMPANY, *Appellee.*

Appeals from the United States District Court for the Southern District of West Virginia, at Charleston.
John A. Field, Jr., Chief District Judge.

(Argued April 3, 1968. Decided July 18, 1968.)

Before BRYAN, WINTER and BUTZNER, Circuit Judges.

John W. Malley and William K. West (Raymond F. Lippitt, and Cushman, Darby & Cushman on brief) for Appellant, and John M. Webb (William H. Webb, and Webb, Burden, Robinson & Webb; David D. Johnson, and Jackson, Kelly, Holt & O'Farrell; and David Young on brief) for Appellees.

ALBERT V. BRYAN, Circuit Judge:

Coal mining patents owned by Wilcox Manufacturing Company, a West Virginia corporation were set at naught by the District Court and the company appeals. The successful parties were the appellees, Eastern Gas and Fuel

Associates, chartered in Massachusetts, and Jeffrey Galion Manufacturing Company, chartered in Ohio. We affirm.[1]

The apparatus patent—the dominant one here—is No. 3,026,098, issued March 20, 1962 and the other is No. 2,-967,701, termed a method patent, issued January 10, 1961. The original application was made August 16, 1954 and was rekindled from time to time by amendments until the issuance of the patents in suit. Both stem from renewal of May 6, 1957, a division of it leading to the method letters. The specifications of the patent, with unimportant additions, have been carried into the patents now questioned.

I. The machine excavates coal by boring into the seam with two parallel augers. Equipped with a bit on the end, the shaft of each auger is helical, that is screw-shaped or spiraled. As the coal is cut and loosened, the screw blades act as a worm, withdrawing and gathering the coal, and delivering it rearwardly. It is called a "continuing miner" because it performs these functions without interruption while it is moved along the face of the stratum by a winch, cables and pulleys. The mechanism is described with simplicity by the District Court as:

> "... comprised of a frame carrying a power plant and conveyor and having a pair of cutting and conveying helical augers disposed forwardly of the frame which augers are horizontally spaced from each other, *rotating* in opposite directions, longitudinally *reciprocated* and *vertically adjustable.*
>
> "The machine is designed so that it can be 'sumped in' [i.e. forced] to the face of the coal, and then moved transversely across the face, cutting the coal to the

[1] This is a consolidated appeal of two actions tried together. In one Wilcox was the unsuccessful plaintiff against Eastern Gas and Fuel Associates for alleged infringement of both its method and apparatus patents (respectively 2,967,701 and 3,026,098). In the other suit Jeffrey as plaintiff sought a declaratory judgment that these two Wilcox patents were invalid.

height of the vein, and continuously conveying the coal so cut outwardly to a point to the rear of the machine where it can be picked up and further conveyed by other auxiliary equipment. At the end of one traverse the machine may be again 'sumped in' and another transverse cut made along the face of the coal in the opposite direction." (Accent added.)

The salient characteristics disclosed are rotation, meaning the drilling movement of the augers; reciprocation, i.e., a cyclical short forward thrust, with immediate retraction, of the augers; and vertical adjustability, defining the potential of manipulation of the augers upward or downward while in a horizontal posture, as needed. Their usage is illustrated in these excerpts from the specifications:

". . . the machine of the present invention is particularly adapted to remove material from a relatively low mine face which may include a vein of impure material."

* * * * *

"It will be understood that where it is desired to dig out a seam of a height higher than the vertical height of the augers themselves, one of the *augers may be raised* relatively to the other so that during the movement of the machine across the mine face, the augers will remove a seam of a height equal to the upper level of the raised auger. At the lateral ends of the seam, the adjacent auger may be either raised or lowered in operation to complete the seam.

"It can thus be seen that there has been provided a continuous mining machine having cutter means which *may be both rotated and reciprocated* longitudinally so as to render the same operable both longitudinally and transversely to the coal face . . . ." (Accent added.)

It was conceded by the patentee that each of the three distinctive features had appeared earlier in pairs but never

in trio. The inventive concept constantly pressed by Wilcox upon the Patent Office was the "combining [of] these three movements in a single cutter". The forgetive and "vital element" asserted by Wilcox, as the District Judge found, was reciprocation. The record fully exposes this to be burden of the Wilcox contentions throughout.

Wicox's president testified at trial:

> Q. "... did you think ... [reciprocation] was essential to the operation of the machine?"
>
> A. "Yes. Actually this was one of Mr. Wilcox's features of the machine."
>
> * * *
>
> Q. "... you believed that you could not successfully cut a vein of coal by rotating augers, pulling the machine across unless you reciprocated those augers, isn't that correct?"
>
> A. "That is correct."

Without reciprocation or its putative equivalent of "critical bit spacing", Wilcox told the Patent Office, the auger cutter could not move transversely and the machine would be inoperable.

In an amendment of the application as late as November 3, 1961, Wilcox again alludes to the indispensability of reciprocation, again claiming the triune of the three features as constituting invention:

> "For the sake of argument it can be admitted that *all* of the structure included in the combination which solved the problem is per se old. It is not these *individual* features which solve the problem but a specific combination of them, and it is this combination which is patentable." (Accent added.)

But then Wilcox omits reciprocation from its patent claims, although disclosing it in its specifications. In its

place, an equivalent—critical or precise bit spacing—is said to appear in the claims. We detect no such language. Nor could the District Judge. He found it was not defined, or otherwise identifiable, anywhere in the patent. Consideration of this element is thus precluded, for the deficiency violates the statutory demand for a clear and exact description of the invention. 35 USC 112.

Evidently the real reason for leaving reciprocation out of the claims was that Wilcox had learned from a buyer that its miner would operate successfully without the reciprocation. Indeed, it had manufactured and sold machines of this type. But by then—1959, almost five years after the application was first filed—the nonreciprocating machine had been in public use for more than a year and Wilcox could not apply for a patent on it. 35 USC 102 (b).

The machine accused here and known as the Jeffrey unit undoubtedly was calculatedly made in the image of the Wilcox miner but without the ingredient of reciprocation. Thus the Jeffrey comes within the Wilcox claims but not within the specifications of that patent. Relying on this coverage, Wilcox declared infringement by the Jeffrey.

We hold the apparatus patent of Wilcox invalid.

To begin with, in averring that the Jeffrey trenches upon its claims, Wilcox must be taken as contending that its claims do not include reciprocation, since the Jeffrey has no such movement. If Wilcox does not claim reciprocation, then its patent is void, under 35 USC 102 (b), because of the prior successful public use of its miner when without reciprocation.

Next, the patent is void because the claims lack support in the specifications. As already explained, the specifications describe a machine embracing reciprocation, and the file wrapper conclusively reveals that it was the predominant predicate of the Wilcox application. The company

cannot now successfully prosecute claims omitting that element.

> "[T]he patent monopoly . . . cannot be enlarged by claims in the patent not supported by the description . . . . ; . . . . the application for a patent cannot be broadened by amendment so as to embrace an invention not described in the application as filed, at least when adverse rights of the public have intervened." [Citations omitted.] Schriber Co. v. Cleveland Trust Co., 305 US 47, 57 (1938).

Cf. Snow v. Lake Shore and Michigan Southern Railway Company, 121 US 617 (1887).

As was later said in Graver Mfg. Co. v. Linde Co., 336 US 271, 277 (1949):

> "We have frequently held that it is the claim which measures the grant to the patentee. . . . While the cases more often have dealt with efforts to resort to specifications to expand claims, it is clear that the latter fail equally to perform their function as a measure of the grant when they overclaim the invention. When they do so to the point of invalidity and are free from ambiguity which might justify resort to the specifications, we agree with the District Court that they are not to be saved because the latter are less inclusive. . . ." [Citations omitted.]

Attempting to rescue the patent, Wilcox would consider as within the claims so much of the specifications as employ reciprocation in describing the machine. The right to refer to the specifications for clarification of the claims cannot be invoked to validate the claims. We said so in Brown v. Brock, 240 F2d 723, 728 (1957) with these words of Judge Sobeloff:

> "While the claims should be construed in the light of the specification to obtain an understanding thereof,

the limitations specified cannot be read into the claims."

Nor can this attempt be justified under 35 USC 112 which allows the use of the term "means", as it appears in the Wilcox claims, to bring into the claims of a combination patent any element described in the specifications. For the introduction is directly contrary to Wilcox's insistent interpretation of its claims—that they cover a machine, such as the Jeffrey, which has no reciprocation.

Thus Wilcox assumes contradictory positions. On one hand, it asks the Court to read reciprocation into the claims in order to preserve the validity of its patent, but on the other hand to read it out in order to find infringement by the Jeffrey.

To permit the patent to stand would mislead the public. The Wilcox claims, if allowed, would exclude machines not employing reciprocation. Since it covers an assemblage of confessedly old constituents, with reciprocation as the keystone, this combination patent would not be invaded by another aggregation which may not include this part of the patented device. Entron of Maryland, Inc. v. Jerrold Electronics Corp., 295 F2d 670, 677 (4 Cir. 1961); Kay Patents Corp. v. Martin Supply Co., 202 F2d 47, 51 (4 Cir. 1953). Yet although dependent as it is upon reciprocation the Wilcox patent might serve as an in terrorem bar to a similar device without this component in its make-up.

Inasmuch as we vitiate the patent on its face in the light of its representation to the Patent Office and the District Court, we have no occasion to put it to the obviousness tests of Graham v. John Deere Co., 383 US 1, 17 (1965). Nor need we weigh the defenses of anticipation or prior art. For the same reasons, commercial success and the other "secondary considerations" are not presently pertinent. Id. 17. We do refer to *Graham,* however, to justify our use of the patent's history. Id. 33.

II. The method patent was applied for June 30, 1960, a bifurcation of the original application. After amendments thereto, the patent issued as No. 2,967,701 on January 10, 1961. In the specifications it at once advises that "This invention relates to mining *methods* and more particularly to mining *methods* of the continuous type in which the coal or other material being mined is continuously conveyed away from the mine face". Its single claim is of "a *process* of continuous short wall coal mining . . . ." The words now underlined in these quotations emphasize that it is not an apparatus patent despite that one of the specifications says, "It can thus be seen that there has been provided a continuous mining machine. . . ."

In truth, this patent's "method" and "process" is fitted to the Wilcox apparatus. The machine it covers is specified in the same terms as is the Wilcox miner patent. It too prescribes reciprocation in the specifications, but the method or process claim contains no allusion to this element. Hence, it must be faulted for the same flaws found in the apparatus patent. Actually, however, this is not a method or process patent. It is merely a statement of how the Wilcox machine is to be operated. Directions of this sort are not patentable. Chisholm-Ryder Co., Inc. v. Buck, 65 F2d 735, 736 (4 Cir. 1933).

The decree of the District Court will be approved.

Affirmed.

UNITED STATES DISTRICT COURT
S. D. WEST VIRGINIA,
CHARLESTON DIVISION.

Civ. A. Nos. 2544, 2721.

WILCOX MANUFACTURING COMPANY, *Plaintiff*,

v.

EASTERN GAS AND FUEL ASSOCIATES, *Defendant*.

JEFFREY GALION MANUFACTURING COMPANY, *Plaintiff*,

v.

WILCOX MANUFACTURING COMPANY, *Defendant*.

July 26, 1967

OPINION

FIELD, Chief Judge.

Civil Action No. 2544 is an action for alleged infringement of United States Letters Patent No. 2,967,701, which issued January 10, 1961, and United States Letters Patent No. 3,026,098, which issued March 20, 1962. The plaintiff is Wilcox Manufacturing Company (hereinafter referred to as "Wilcox"), a West Virginia corporation, having its principal place of business in Raleigh, West Virginia. The defendant is Eastern Gas and Fuel Associates (hereinafter referred to as "Eastern"), a Massachusetts corporation, having regular and established places of business at Kopperstown and Barrett, West Virginia.

Civil Action No. 2721 is an action for a declaratory judgment that United States Letters Patent Nos. 2,967,701 and 3,026,098 are invalid and have not been infringed. The defendant asserted a counterclaim for alleged infringement of Patent No. 3,026,098. The plaintiff in Civil Action No. 2721 is Jeffrey Galion Manufacturing Company, an Ohio corporation, having its principal place of business at Colum-

bus, Ohio. The Jeffrey Manufacturing Company is a division of Jeffrey Galion Manufacturing Company. Both will be referred to hereinafter as "Jeffrey." The defendant in Civil Action No. 2721 is Wilcox.

Jurisdiction over the parties and the subject matter of Civil Action No. 2544 is founded upon 28 U.S.C.A. § 1338(a) and is not disputed. Jurisdiction over the parties and subject matter of Civil Action No. 2721 is founded upon 28 U.S.C.A. §§ 1332(a), 1338(a), 2201 and 2202 and is not disputed.

The principal issues in both actions are the validity of the Wilcox patents and the alleged infringement of those patents by Jeffrey 100-L miner. Accordingly, the two actions were consolidated for trial.

The two patents involved in this litigation issued on applications filed by Arnold G. Wilcox, and Wilcox Manufacturing Company is the owner of the entire right, title and interest in and to these patents. Patent No. 2,967,701 which covers a method of mining, issued on an application filed June 30, 1960, Serial No. 40,014, and Patent No. 3,026,098 which covers a mining machine issued on an application filed May 8, 1961, Serial No. 108,371. Both of these applications were based on a prior application filed May 6, 1957, Serial No. 657,160, which is alleged by Wilcox to be a continuation-in-part of Wilcox application Serial No. 449,851, filed August 16, 1954.

Jeffrey and Eastern contend that Wilcox Patent No. 3,026,098 is invalid for the following reasons:

(1) The apparatus which the patent purports to cover was obvious to those skilled in the art at the time of the alleged invention, and therefore the patent lacks invention under 35 U.S.C.A. § 103.

(2) The claims contended for in this litigation by Wilcox are broader than any invention disclosed in the patent, and therefore the patent is invalid for overclaiming

(3) The apparatus which Wilcox contends is covered by the claims of the patent was in public use and on sale more than one year prior to the assertion of claims covering that apparatus.

These parties also challenge the validity of the Method Patent No. 2,967,701 for the following reasons:

(1) The method which the patent purports to cover was obvious to those skilled in the art at the time of the alleged invention and accordingly the patent lacks invention as required by 35 U.S.C.A. § 103.

(2) The claim of this patent purportedly covers merely the method of using the apparatus shown in the patent and therefore is invalid and improper as a method claim.

(3) The specification does not describe an operative method of mining and accordingly the patent is invalid for failure to contain a description of the invention in such terms as to enable any persons skilled in the art to practice it as required by 35 U.S.C.A. § 112.

Additionally, it is charged that foreign applications were filed with respect to both of the patents which included subject matter that had been filed in the United States Patent Office less than six months prior to the filing of the foreign applications and accordingly the patents are invalid under 35 U.S.C.A. § 185.

While both of the Wilcox patents are in issue in these actions, disposition depends primarily on the question of validity of the apparatus patent No. 3,026,098. The first Wilcox application No. 449,851 which was filed on August 16, 1954, states that the invention relates to mining machines of the continuous type, and that it is particularly adapted for use in mines having a relatively low face. The specification describes the machine as comprised of a frame carrying a power plant and conveyor and having a pair of cutting and conveying helical augers disposed forwardly of the frame which augers are horizontally spaced from

each other, rotating in opposite directions, longitudinally reciprocated and vertically adjustable.

The machine is designed so that it can be "sumped in" to the face of the coal, and then moved transversely across the face, cutting the coal to the height of the vein, and continuously conveying the coal so cut outwardly to a point to the rear of the machine where it can be picked up and further conveyed by other auxiliary equipment. At the end of one traverse the machine may be again "sumped in" and another transverse cut made along the face of the coal in the opposite direction. The maximum vertical dimensions of the frame are less than the vertical dimension of the cutting augers and, accordingly, the opening cut by the augers is high enough to accommodate the entire machine as the room is developed.

Incident to this first application, Wilcox took the position that he was the first to provide a cutter with the combination of (1) rotation, (2) reciprocation and (3) vertical adjustment. Since it bears vitally on both the question of obviousness and infringement, I think it appropriate to refer to the following excerpts from the specification which appear in the initial application as well as the patent No. 3,026,098 as it finally issued. The combined rotary and reciprocatory motion of the cutters is described as follows:

> "The housing 36 is adapted to carry a suitable means 40 for transmitting the rotary motion of the power plant to the cutting means 14 so as to selectively reciprocate the latter longitudinally. While the means 40 may take many forms, a preferred embodiment is shown in detail in Figures 5 and 6. As shown, a main shaft 42 is drivingly connected with the power plant 16, through a suitable clutch mechanism 44, and has its rear end splined, as at 46, so that it may reciprocate axially therein.
>
> * * * * * * * * *

"It will be seen that when the stub shaft 52 is rotated that the cam 62 and follower 66 will cause the transmission housings 36 and 38 to longitudinally reciprocate with respect to the main frame and power plant."

Similarly, the operation of the machine refers to this combined rotary and reciprocating motion:

"During this sumping operation, the clutch linkage 60 is actuated to disengage the clutch teeth 54 and 56 so that the cutting augers will not be reciprocated longitudinally.

* * * * * * * * *

"The clutch linkage 16 is then actuated by the operator to bring the clutch teeth 54 and 56 into engagement so that the augers will be longitudinally reciprocated through the main shaft 42, bevelled gears 48 and 50, shaft 52, cam 62 and plate cam follower 64 and 66. In this regard, it is to be understood that since the plate 64 is rigid with the power plant and main frame, the sub-frame 28 and all of the structural elements carried thereby, including housings 36, 38, and 76 will be caused to longitudinally reciprocate. The operator may then actuate the winches 20 to cause the machine to move across the mine face and during this movement the combined rotary and reciprocating motion of the cutter will cause the teeth 108 and 102 to loosen the coal which will then be conveyed rearwardly by the helical blades 96 from where it is conveyed to the rear of the machine by the screw conveyor 112 and endless conveyor 114.

* * * * * * * * *

"After the pure coal has been removed and collected as described above, the operator may then selectively raise the augers by actuation of the associated hydraulic ram 90. It is to be noted that during this raising motion the auger is both rotated and reciprocated."

[1, 2] The scope of the Wilcox patent is limited to the invention described in the claims read in the light of the

specification, and each of the claims must necessarily be construed in the light of the specification and may not transcend the invention disclosed thereby. See Texas Co. v. Globe Oil & Refining Co. (7th Cir. 1955) 225 F.2d 725. It is also well settled that an invention should be construed not only in the light of the specification and the claims, but also with reference to the file wrapper history in the Patent Office. Graham v. John Deere Co., 383 U.S. 1, 33, 86 S.Ct. 684, 15 L. Ed. 2d 545. Since the language of the specification hereinabove quoted appeared in both the original Wilcox application as well as in the apparatus patent which finally issued to him, it is both desirable and necessary in the disposition of this case to review the history of the proceedings in the Patent Office during the seven and one-half years the Wilcox applications were pending therein from the date of the original application in 1954 until the issuance of the patents in March of 1962.

Patent Office Proceedings

As hereinbefore stated the first application Serial No. 449,851 was filed by Wilcox in the Patent Office on August 16, 1954, the specification in that application containing the details and language hereinbefore quoted. Thirteen claims were filed with the original application, and the first action of the Patent Office was a requirement that the claims be restricted to either the mining machine or the mining head described therein. On March 30, 1956, the Patent Office rejected all of the claims to the mining machine as unpatentable over the prior art and asked for additional disclosure by means of drawings inasmuch as the showing of the drawings of the mountings for the cutter and the means for reciprocation of the cutters was not clear.

By amendment dated May 23, 1956, Wilcox cancelled all the original claims except Claim 11 and added four new claims. All of the claims retained in the application specifically required means for reciprocating the cutters, and

Wilcox distinguished the prior art cited by the Office on the ground that none of the art showed the combination of the three specific motions required by the machine in his application, namely, rotation, reciprocation and vertical adjustment. Indeed, Wilcox admitted that the combination of rotation and vertical adjustment was old, and that rotation together with reciprocation was disclosed by Hurd Patent No. 556,986 and Hess Patent No. No. 999,996. On July 31, 1956, Wilcox amended the application to include new drawings showing the mounting for the cutters and the means for reciprocating the same. Additionally, Wilcox added a new claim which required only one auger, and asserted that the single auger machine was a part of the same invention and that the number of cutters did not affect the patentability of the machine, the invention residing in the three motions, namely, rotation, reciprocation and vertical adjustability. The Patent Office refused to allow the single auger claim, but did allow five claims directed to the two auger machine, all of which required the three motions heretofore detailed. Wilcox did not pay the final fee and this application was forfeited.

One day before the original application was forfeited, Wilcox filed a continuation-in-part application Serial No. 657,160 which contained the same disclosures as the original application as amended, and also included an extensive description of a single auger machine. Fifteen claims were filed with this application and were directed to a machine which specifically required the three elements which Wilcox had alleged in his original application. Incident to this application which was filed as of May 15, 1958, Wilcox distinguished his machine from the prior art on the basis of the reciprocatory motion disclosed in the application, and apparently believed and so represented to the Patent Office that reciprocation was essential to the operation of the apparatus, and that without it the auger cutter could not be successfully moved transversely across the mining seam. On October 28, 1958, Wilcox filed a sup-

plemental amendment covering an application for a claim to a process of continuous short wall mining. On December 29, 1958, the Patent Office allowed ten apparatus claims, all of which expressly required reciprocation, but declined to consider the process claim.

On June 29, 1959, more than four years after the original application was filed and more than three years after Wilcox had sold its first mining machine, Wilcox inserted a claim which did not specifically require reciprocation, asserting that a critical bit spacing on the augers was equivalent to reciprocation and could be substituted therefor. There was no disclosure defining this critical bit spacing which was alleged to be the equivalent of reciprocation. A supplemental amendment dated December 9, 1959, was filed, and in an interview the Examiner took the position that claims without reciprocation were broader than the applicant's invention. Wilcox asserted that reciprocation had not merely been eliminated from the claims, but that the language had been broadened to require reciprocation or its equivalent, asserting that without either reciprocation or its equivalent, the claims would cover an inoperative structure. On December 22, 1959, the Patent Office allowed fifteen claims including claims to both single and dual auger machines, but the Examiner refused to allow claims which did not expressly include reciprocation. Subsequently Wilcox filed an amendment cancelling all claims expressly including reciprocation and presenting new claims, all of which contained phraseology which Wilcox asserted required reciprocation or its equivalent.

The Examiner proposed a claim for interference purposes and on June 17, 1960, Wilcox inserted the claim in his application. On July 20 an interference was declared between the Wilcox application and an application of Thomas H. Queer. On March 20, 1961, Wilcox voluntarily cancelled all claims which related to a single auger machine, and on July 9, 1962, the Examiner acted upon the amendments filed by Wilcox. At this time the Wilcox

apparatus patent No. 3,026,098 had issued and the Examiner rejected all claims in the application as unpatentable over that patent. Thereafter, Wilcox abandoned this application.

Throughout the interference proceeding, Wilcox asserted that the subject count was unpatentable, and that two slight differences, to-wit, reciprocation or its equivalent and vertical adjustment, were the factors which created patentability in the machine of Wilcox. Ultimately Wilcox disclaimed the subject matter of the count, and the count eventually issued as a claim in U. S. Patent No. 3,066,924 issued to Thomas H. Queer.

On May 8, 1961, following the Patent Office action in denying the Wilcox motion to dismiss the interference with Mr. Queer, Wilcox filed a fourth application Serial No. 108,371 alleged to be a division of the 1957 application. The description of the invention was identical with that in the 1957 application and the specification disclosed a machine in which a pair of auger cutters were rotated and longitudinally reciprocated as the machine was drawn transversely across the face of the coal, and which included an improved form of vertical adjustment. There was no disclosure that the machine could operate without longitudinal reciprocation of the cutters. On September 1, 1961, the Examiner rejected all claims in the application, first, because the claims were not related to an independent invention from that claimed in the Wilcox application involved in the interference, and, second, because all claims were unpatentable over the disclosure of the Queer application. It should be noted that the Examiner specifically held that the vertical adjustability of the cutters was an expedient within the skill of the art and that making the cutters of equal diameter and of opposite pitch was a mere matter of engineering choice. Wilcox agreed to cancel all conflicting claims in the application involved in the interference if those claims were allowed in this new appli-

cation. Following a further interview and supplemental amendment, a rejection by the Examiner on the ground that the claims were indefinite, and a further amendment, the Wilcox apparatus patent No. 3,026,098 finally issued on March 20, 1962.

The Method Patent

Shortly after the notice of interference was issued by the Patent Office, on June 30, 1960, Wilcox filed a new application Serial No. 40,014 which he claimed was a division of the 1957 application. The description of the alleged invention was substantially the same as that contained in the 1957 application, but the specification stated that the invention related to mining methods. The single claim in the application was directed to a method of mining although the specification stated that there had been provided a continuous mining machine. In any event, on September 16, 1960, the Patent Office rejected this claim as fully met by the Hess patent.

Following an interview with the Examiner on October 3, 1960, the application was amended cancelling the original claim and adding two new claims. Claim 2 recited the process in procedural language while Claim 3 recited the process in terms of the manner in which the apparatus described therein was to be used. Claim 2 was rejected by the Examiner while Claim 3 was allowed.

On January 10, 1961, Wilcox Patent No. 2,967,701 issued with one claim, the Claim 3 above referred to, which is directed to the manner in which the apparatus described in the specification is to be used. The claim of this method patent sets forth three operative steps which are (1) sumping [1] in the augers, (2) moving the augers horizontally

[1] The term "sump in" as used in the coal industry is apparently of long standing and well defined. It means that by the assistance of a winch, rope and pulleys, the cutting augers may be pushed inwardly against the mine face until they cut to their working depth into the vein of coal.

to cut and convey the coal outwardly and vertically to form the sidewalls, and (3) continuously gathering and conveying the coal.

The Prior Art

[3] While counsel for Wilcox have in effect conceded that each of the elements contained in the apparatus patent were known and disclosed by the prior art, a brief review of the art as disclosed in the Patent Office antecedent to the Wilcox patent is helpful.[2] Representative of the patents on the subject and a summary of the elements therein is as follows:

Queer United States Patent No. 3,066,924. This, of course, was the patent involved in the interference with Wilcox in the proceedings in the Patent Office. It clearly teaches a plurality of cutting augers, vertical adjustment, the sumping operation, the transverse movement across the vein of coal to be cut and the simultaneous conveying of the coal.

Anderson United States Patent No. 2,592,996. While this machine was designed for "long wall mining" procedure, it does teach a plurality of horizontally spaced cutting elements, vertical adjustment, transverse cutting of the seam and conveying of the coal.

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[2] Counsel for Wilcox characterized the prior art patents as "merely paper patents" which had no practical impact on the coal industry. However, on the issue of invention this argument of Wilcox was answered by the following observation of Judge Learned Hand in Western States Mach. Co. v. S. S. Hepworth Co. (2nd Cir. 1945) 147 F. 2d 345, at 350:

> "A patent may have lain for years unheeded, as little a contribution to the sum of knowledge as though it had never existed, an idle gesture long since drifted into oblivion. Nevertheless, it will be as effective to invalidate a new patent, as though it had entered into the very life blood of the industry."

Walker United States Patent No. 1,500,352. This patent teaches the plurality of cutting elements, vertical adjustment, the sumping procedure, transverse cutting of the coal and conveying thereof.

Hess United States Patent No. 1,032,902 and United States Patent No. 1,006,213. These patents teach the use of an auger as a cutting element, reciprocation of the cutting element, vertical adjustment, the sumping process, the transverse movement across the vein of coal and the conveying thereof.

Hoadley United States Patent No. 1,040,679. This patent teaches a plurality of cutting elements horizontally spaced with vertical adjustment, the sumping procedure, the transverse cutting of the coal and the conveying thereof.

Kuhn United States Patent No. 1,148,973. This patent teaches the plurality of cutting augers horizontally spaced, with vertical adjustment, capable of sumping into the face of the coal and cutting of the coal transversely.

Discussion

[4, 5] The Wilcox patents are, of course, entitled to the presumption of validity under 35 U.S.C.A. § 282. This presumption does not, however, relieve the Court of the responsibility of inquiry as to validity. This judicial inquiry in regard to the Wilcox apparatus patent must be made in the light of Mr. Justice Jackson's classic admonition in Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp. 1950 340 U.S. 147, at 152, 71 S. Ct. 127, at 130, 95 L.Ed. 162:

> "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. The function of a patent is to add to the sum

of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans."

[6] Patentability is dependent upon novelty and utility as defined in 35 U.S.C.A. §§ 101 and 102, and non-obviousness as expressed in the 1952 Act in § 103 as follows:

"§ 103. *Conditions for Patentability; non-obvious subject matter*

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made."

Patentability, especially in the light of § 103 was carefully analyzed in Graham v. John Deere Co., supra (1965). In the course of this analysis Mr. Justice Clark made the following observations (at p. 14 of 383 U.S., at p. 692 of 86 S.Ct.):

"The section is cast in relatively unambiguous terms. Patentability is to depend, in addition to novelty and utility, upon the 'non-obvious' nature of the 'subject matter sought to be patented' to a person having ordinary skill in the pertinent art."

And at page 17, 86 S.Ct. at p. 693:

"Approached in this light, the § 103 additional condition, when followed realistically, will permit a more practical test of patentability. The emphasis on non-

obviousness is one of inquiry, not quality, and, as such, comports with the constitutional strictures.

"While the ultimate question of patent validity is one of law, Great A. & P. Tea Co. v. Supermarket Equipment Corp., supra, 340 U.S. at 155, 71 S.Ct. at 131, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy."

The record in the present case indicates clearly that each of the elements of the combination in the Wilcox apparatus patent is old and fully disclosed in the prior art. While undoubtedly the combination was a useful and successful improvement, it does not in my opinion rise to the level of invention. See Interstate Rubber Prod. Corp. v. Radiator Specialty Co. (4th Cir. 1954) 214 F.2d 546; American Monorail Co. v. Parks-Cramer Co. (4th Cir. 1957) 245 F.2d 739. The arrangement of these old elements into a compact and movable machine which could operate in a low-roof mine may have required a high degree of mechanical skill, but did not constitute invention within the meaning of the patent law. See Ranco, Inc. v. Gwynn (6th Cir. 1942) 128 F.2d 437. American Morgan Co. v. Joy Mfg. Co. (D.C.W.D.Pa.1939) 31 F. Supp. 419. The machine produced and marketed by Wilcox enjoyed a high degree

of commercial success and this fact was emphasized by counsel for Wilcox throughout the Patent Office proceedings; but commercial success is not the criterion and without invention it will not support patentability. Servo Corp. of America v. General Electric Co. (4th Cir. 1964) 337 F.2d 716; Triumph Hosiery Mills, Inc. v. Alamance Industries, Inc. (4th Cir. 1962) 299 F.2d 793.

In addition to commercial success, as heretofore pointed out, Wilcox consistently urged in the Patent Office that his machine was the first to successfully combine the three elements of rotation, reciprocation and vertical adjustability. However, the concurrent developments in the production and use of the Wilcox machines in the mining industry do not support those representations and, indeed, provide evidence which is fatal to Wilcox's case.

The record indicates that the original mining machines manufactured and sold by Wilcox broadly corresponded to the machines disclosed in the patents involved in this litigation. Those machines had two horizontally spaced augers which were rotated and reciprocated and which were vertically adjustable. However, the record further shows that since June 6, 1958, Wilcox has sold no machine which contains an oscillator to reciprocate the augers. The record shows that as early as May 21, 1958, Stonega Coal Company, which was using a machine purchased from Wilcox, discovered that in the practical use of the machine reciprocation of the augers could be eliminated and had removed the oscillators from the machine. Since June of 1958, the machines which were sold by Wilcox and a large majority of the machines presently in use do not have such oscillators and do not include reciprocation as a part of the operation of the machine.

As heretofore noted in the review of the Patent Office proceedings, Wilcox apparently recognized that reciprocation was not a necessary element of his invention when on June 29, 1959, he first inserted a claim which did not spe-

cifically require reciprocation. The Examiner properly rejected the claims which did not include reciprocation, and in response to Wilcox's contention that "critical bit spacing" was the equivalent of reciprocation in the combination the Examiner made this observation:

> "No new or unobvious results are seen in providing the reference with a pair of concentric helical blades. As pointed out by applicant, the pair of blades may have significance in connection with critical spacing of cutting teeth but no such spacing is disclosed or claimed."

In the light of the entire record the Wilcox apparatus patent falls short of validity on three grounds:

First, when the element of reciprocation is eliminated from the combination, the residue of the claimed invention should have been clearly obvious to those skilled in the art, and accordingly the patent is invalid for lack of invention under 35 U.S.C.A. § 103. The prior art cited herein anticipates every element of the Wilcox machine, and as stated in Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., supra, 340 U.S. at 153, 71 S.Ct. at 130, Wilcox " * * * has added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them in congregation as a monopoly."

I might state here that the contention of Wilcox that "critical bit spacing" is the equivalent of reciprocation in the combination is not supported by the record. First of all, nowhere does there appear any definition of this critical spacing; and, second, the record shows that machines which were sold by Wilcox before such critical bit spacing was substituted for reciprocation apparently operated satisfactorily when reciprocation was entirely eliminated by the operator.

Second, the Wilcox patent specifically discloses a machine in which reciprocation is a vital element, and any

attempt to construe the claims in a manner which does not require reciprocation or its equivalent renders them invalid for overclaiming by purporting to cover a combination not disclosed in the patent. See Schriber-Schroth Co. v. Cleveland Trust Co. (1938) 305 U.S. 47, 59 S.Ct. 8, 82 L.Ed. 34; Plax Corporation v. Precision Extruders, Inc. (3rd Cir. 1957) 239 F.2d 792.

Third, assuming that critical bit spacing in the context of the claimed combination does, in fact, exist, as the Examiner pointed out such spacing is neither disclosed nor claimed in the patent, and accordingly Wilcox has failed to satisfy the requirements of 35 U.S.C.A. § 112 which requires a clear and concise description of the invention.

These observations relative to the invalidity of the apparatus patent apply in a large degree to Method Patent No. 2,967,701. Additionally, however, this method patent falls because the claim sets forth merely the manner in which the apparatus is used. As stated in Chisholm-Ryder Co. v. Buck (4th Cir. 1933) 65 F.2d 735, 736:

> "Thus it appears that the method proposed may be performed by the patented machine; but the evidence fails to indicate how the process may be carried out practicably in any independent fashion, and the result is that the process patent merely states the function or effect of the machine, and is invalid under the established rule."

In view of my conclusions on the issues of validity, it is unnecessary to pass on the question of alleged infringement. However, some brief observations on this issue are pertinent.

First of all, the record clearly shows that Jeffrey, influenced by the success of the Wilcox machine, studiously copied the Wilcox product and placed on the market the Jeffrey 100-L which was to a large degree

a duplication of the machine being produced and sold by Wilcox. In the absence of a valid patent by Wilcox, however, Jeffrey was entitled to engage in such competitive conduct. Sears, Roebuck & Co. v. Stiffel Co. (1964) 376 U.S. 225, 84 S.Ct. 784, 11 L.Ed.2d 661. And even should we assume the validity of the Wilcox Patent No. 3,026,098 as issued, the Jeffrey machine does not infringe since it omitted one essential element of the Wilcox patent, that is reciprocation or its equivalent. Under these circumstances infringement could not be established. See Entron of Maryland, Inc. v. Jerrold Electronics Corp. (4th Cir. 1961) 295 F.2d 670. Suffice it to say, that the observations with respect to both validity and infringement apply in these cases equally, where appropriate, to Eastern as well as Jeffrey.

Conclusions of Law

1. This Court has jurisdiction over the parties and the subject matter of Civil Action No. 2544 and Civil Action No. 2721.

[7] 2. The Wilcox Patent No. 3,026,098 is invalid because the subject matter thereof was obvious to those skilled in the art at the time the alleged invention was made. Therefore, the patent is invalid for lack of invention under 35 U.S.C.A. § 103.

3. The Wilcox Patent No. 3,026,098 is invalid because the claims, in the scope contended for here, are broader than any invention disclosed in the patent or any invention made by Mr. Wilcox. The claims of such scope are invalid for overclaiming.

4. The Wilcox Patent No. 2,967,701 is invalid because the method which the patent purports to cover was obvious to those skilled in the art at the time the alleged invention was made. Therefore, the patent is invalid for lack of invention under 35 U.S.C.A. § 103.

[8] 5. The Wilcox Patent No. 2,967,701 is invalid because the claim of the patent covers merely the method of using the apparatus disclosed in the patent.

6. The Wilcox Patent No. 3,026,098 has not been infringed by Jeffrey. The manufacture, sale and use of the Jeffrey 100-L miner does not infringe Wilcox Patent No. 3,026,098.

7. The Wilcox Patent No. 3,026,098 has not been infringed by Eastern.

8. The Wilcox Patent No. 2,967,701 has not been infringed by Jeffrey. Mining operations carried out with the Jeffrey 100-L miner in accordance with the operating procedures recommended by Jeffrey do not infringe Wilcox Patent No. 2,967,701.

9. The Wilcox Patent No. 2,967,701 has not been infringed by Eastern.

This opinion is being filed in lieu of findings of fact and conclusions of law pursuant to Rule 52 F.R.Civ.P., and counsel may prepare appropriate judgment orders in each case.

Title 35, United States Code, Section 112

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. (Amended July 24, 1965, Public Law 89-83, sec. 9, 79 Stat. 261.)

SUPREME COURT, U. S.

FILED
DEC 30 1968
JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

NO. 786

WILCOX MANUFACTURING COMPANY, Petitioner,

v.

JEFFREY GALION MANUFACTURING COMPANY, Respondent.

BRIEF FOR RESPONDENT IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1968

NO. 786

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No valid reason exists for the granting of the requested writ.

The holding sought to be reviewed is not in conflict with the decisions of this Court. It is not in conflict with the law applied in other Circuits. Nor does it involve an issue of public importance. This is a conventional suit for patent infringement in which both the Court of Appeals and the District Court held the patents invalid on grounds thoroughly established by prior decisions of this Court and uniformly followed by all Courts of Appeals. Petitioner seeks review of the ultimate holding of the lower courts, but does not challenge the basis for that holding. Instead, petitioner has postulated a question for review which has no factual basis in the record

THE QUESTION PRESENTED.

Petitioner's statement of the question presented misstates the holding of the Court below. The lower courts did *not* hold the patents in suit invalid "on a technical point of Patent Office practice" (Petition, p. 3). Both courts held the patents invalid because the claims, in the scope urged by the patentee, were broader than any invention disclosed in the patent, hence, were not supported by the specification (App. 5a-6a, 24a-25a, 26a).

Thus, the sole question which can properly be presented on this record is whether a patent claim which is broader than the invention disclosed in the patent and which is not supported by the specification is invalid.

STATEMENT OF THE CASE.

Petitioner's "Statement of the Case" is factually accurate but woefully incomplete. The factual background presented in petitioners "Argument" is grossly inaccurate.

Petitioner was granted two patents. United States Letters Patent No. 2,967,701, issued January 10, 1961, purports to cover a method of mining. United States Letters Patent No. 3,026,098, issued March 20, 1962, purports to cover a mining machine. Both patents are based on a single application filed August 16, 1954.*

Shortly after issuance of the method patent, petitioner filed an ordinary infringement action against Eastern Gas and Fuel Associates, a customer of respondent, charging Eastern with infringement by reason of its use of a machine purchased from respondent and other machines made by Eastern. Promptly after the issuance of the apparatus patent, petitioner filed a supplemental complaint charging Eastern with infringement of the apparatus patent. Since a machine which respondent sold to Eastern was charged to infringe both patents, respondent agreed to take over the defense of the suit and filed a Declaratory Judgment action seeking a declaration that the patents were invalid and not infringed by respondent's machine. The two actions were consolidated for purposes of trial.

In a thorough opinion (App. 9a-27a) the District Court held the apparatus patent No. 3,026,098 invalid

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*Although both patents are in suit, petitioner has referred only to the apparatus patent No. 3,026,098 in its Petition.

on two independent grounds. First, the Court held the patent invalid because the subject matter thereof was obvious to those skilled in the art at the time the alleged invention was made (App. 24a, 26a). Second, the Court held that the patent was invalid for overclaiming because the claims, in the scope asserted, were broader than any invention disclosed in the patent or made by Mr. Wilcox (App. 24a-25a, 26a). The Court also pointed out that if a critical bit spacing existed, as petitioner from time to time asserted, the patent would be invalid for failure to give a clear and concise description of that critical bit spacing as required by 35 U.S.C. Section 112 (App. 25a).

The District Court stated that the foregoing holdings applied in large degree to the method patent. Additionally, it held the method patent invalid since it claimed merely the manner in which the apparatus is used (App. 25a). Finally, the Court held that neither respondent nor Eastern infringed either of the two patents (App. 26a, 27a).

The Court of Appeals for the Fourth Circuit affirmed the District Court. The Court of Appeals held that the claims of the apparatus patent were not supported by the specification, that they omitted an essential element (reciprocation) of the combination disclosed and, hence, were invalid; they overclaimed any possible invention (App. 5a-6a). Since the Court approved and affirmed the second ground on which the District Court held the patent invalid, it was unnecessary for the Court of Appeals to consider the other reason for the invalidity of the patent discussed by the District Court or the holding of non-infringement. Therefore, the Court did not

review the holding that the subject matter claimed was obvious to those skilled in the art. The Court of Appeals also noted that the asserted critical bit spacing was not defined or identifiable in the patent and, thus, consideration of that element was precluded by 35 U.S.C. Section 112. The Court of Appeals did point out that machines without the essential element (reciprocation) had been in public use more than a year prior to the first assertion by the patentee that a machine without that element was operable, as the District Court found (App. 23a-24a), and, therefore, claims not including that element also were invalid under 35 U.S.C. Section 102(b) because of the prior public use (App. 5a).

The Court of Appeals held the method patent invalid on the same ground that it held the apparatus patent invalid, namely, overclaiming (App. 8a). Further, the Court of Appeals, as did the District Court, held the patent invalid as a statement of how the machine is to be operated (App. 8a). Petitioner has not asserted error in the Court's decision regarding the method patent; therefore, respondent will not refer to it further.

ARGUMENT.

Although it is difficult to determine from the Petition the reason or reasons petitioner seeks review by this Court (other than petitioner's belief that the concurrent holdings of the lower Court are wrong), it appears from the "Conclusion" to be that the Court below decided a federal question in a way which is in conflict with the applicable decision of this Court (Petition, p. 14). Two conflicts are apparently asserted. First, petitioner claims the Court below erroneously applied the file wrapper estoppel doctrine contrary to the decisions of this Court. Second, petitioner asserts the Court below misapplied this Court's decisions in *Graham et al. v. John Deere Co.,* (1966) 383 U.S. 1 and *United States v. Adams et al.,* (1966) 383 U.S. 39. Neither contention is sound. There is no conflict with the decisions of this Court.

I.

The Court below did not "summarily 'vitiate' the Wilcox patent . . . on a highly technical point of Patent Office practice called file wrapper estoppel" (Petition, p. 4). It did not hold that "Wilcox was estopped to reinstate the combination claims without the reciprocation feature"; and, it did not invalidate the patent "erroneously relying on file wrapper estoppel" (Petition, p. 12). The Court of Appeals did not refer to or rely on any estoppel, file wrapper or otherwise, in its holding. Petitioner's reference to file wrapper estoppel is a ruse to hide the true basis for the decisions of the lower Courts and to create a basis for review of those decisions by this Court.

The actual basis for the decision was succinctly stated by the Court of Appeals, namely, "the patent is void because the claims *lack support in the specifications*"* (App. 5a). The District Court similarly clearly stated the basis for its holding — the claims are invalid "for overclaiming by purporting to cover a combination *not disclosed in the patent*" (App. 25a). The patent code, 35 U.S.C. Section 112, requires that the "specification shall contain a written description of the invention . . . . in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains . . . . to make and use the same."** This Court has repeatedly held patent claims invalid when they are not supported by the specification, i.e., when the invention claimed is not disclosed by the specification. In *Permutit Co. v. Graver Corporation,* (1931) 284 U.S. 52, 57, this Court held the patent in suit "invalid for lack of the disclosure prescribed by R.S. § 4888."*** This Court pointed out that there was "no mention in the specification of either a 'free' or a 'locked' zeolite bed; or the alleged discovery that a rising space above the zeolite bed is necessary for the successful operation of the softener." Similarly, in this case there was no mention in the specification of a workable machine without reciprocation. The District Court held that the

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*Emphasis ours throughout unless otherwise noted.

**This requirement should not be confused with the further requirement of 35 U.S.C. Section 112 that they must also include "the best mode contemplated by the inventor of carrying out his invention." These are two separate requirements.

***R.S. § 4888 was embodied in 35 U.S.C. Section 112 when the patent laws were codified in 1952.

"patent specifically discloses a machine in which reciprocation is a *vital* element" (App. 24a); and the Court of Appeals held that it was "the predominant predicate of the Wilcox application" (App. 5a).

In *Schriber-Schroth Co. v. Cleveland Trust Co. et al.,* (1938) 305 U.S. 47, this Court considered the function of the specification and stated (p. 57):

> "It follows that the patent monopoly does not extend beycnd the invention described and explained as the statute requires, *Permutit Co. v. Graver Corporation, supra,* at 57; that *it cannot be enlarged by claims in the patent not supported by the description, Snow v. Lake Shore & M. S. Ry. Co.,* 121 U.S. 617; cf. *Smith v. Snow,* 294 U.S. 1; and that the application for a patent cannot be broadened by amendment so as to embrace an invention not described in the application as filed, at least when adverse rights of the public have intervened. *Railway Co. v. Sayles,* 97 U.S. 554, 563, 564; *Powers-Kennedy Corp. v. Concrete Co.,* 282 U.S. 175, 185-186; cf. *Webster Electric Co. v. Splitdorf Electrical Co.,* 264 U.S. 463; *Permutit Co. v. Graver Corporation, supra; Crown Cork & Seal Co. v. Gutmann Co.,* 304 U.S. 159."

And in *Graver Tank & Mfg. Co., Inc. et al. v. Linde Air Products Co.,* (1949) 336 U.S. 271, 277, this Court held claims invalid because they were too broad and were not limited to the invention taught by the specification, stating:

> "While the cases more often have dealt with efforts to resort to specifications to expand claims, it is clear that the latter fail equally to perform their

> function as a measure of the grant *when they overclaim the invention.* When they do so to the point of invalidity and are free from ambiguity which might justify resort to the specifications, we agree with the District Court that they are not to be saved because the latter are less inclusive. *Cf. General Electric Co. v. Wabash Co.,* 304 U.S. 364, 373-374; see *McClain v. Ortmayer,* 141 U.S. 419, 424-425; *Cimiotti Unhairing Co. v. American Fur Refining Co.,* 198 U.S. 399, 410."

Both the District Court and the Court of Appeals relied upon and correctly applied the law as stated in those decisions of this Court. The patents in suit were held invalid because the claims were broader than the invention taught by the specification. As stated by the District Court "any attempt to construe the claims in a manner which does not require reciprocation or its equivalent renders them invalid for overclaiming by purporting to cover a combination not disclosed in the patent" (App. 25a).

Neither Court held the patent invalid because of file wrapper estoppel. Reference was made to the file history, as stated by the Court of Appeals, solely for the purpose of assisting in a determination of the nature of the invention (App. 7a). This Court authorized and required such reference in the *Graham* case, *supra,* at page 33, where it stated that "an invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office."

Petitioner's argument that the Court of Appeals erroneously applied the doctrine of file wrapper estoppel misstates the holdings below.

II.

Petitioner apparently asserts that the Court of Appeals erred in not passing on the obviousness of the alleged invention and, in so doing, "did not heed the commands of" the *Graham* case, *supra* (Petition, p. 13). There is no substance in this assertion. The *Graham* and the *Adams* cases, *supra,* both relate solely to the question of obviousness and interpretation of 35 U.S.C. Section 103. The Court of Appeals had no occasion, as it expressly observed, to consider the question of obviousness since the patent was invalid for failure to comply with the requirements of 35 U.S.C., Section 112. To consider the obviousness of an alleged invention when the patent is patently invalid for failure to comply with the requirements of 35 U.S.C., Section 112 would be superfluous. The course followed by the Court of Appeals was the same course followed by this Court in *Permutit Co. v. Graver Corporation, supra, stated above.* This Court held the patent there under consideration invalid for failure to comply with R.S., Section 4888, the precedent of 35 U.S.C., Section 112 and stated in so holding "We have no occasion to consider whether this alleged Gans invention of a 'free' zeolite bed rises to the dignity of invention or whether, as Graver Corporation contends, it lacked novelty, and was anticipated by earlier apparatus and publications." Thus, this Court, after determining the patent was invalid for an inadequate specification, did not consider the superfluous question of invention or obviousness. The Court of Appeals followed this course and found "no occasion to put it [the claimed invention] to the obviousness tests of Graham v. John Deere Co" (App. 7a). This is clearly the proper course. It should also be pointed out that the District

Court did, in fact, pass on the obviousness of the alleged invention and specifically held that "the subject matter thereof was obvious to those skilled in the art at the time the alleged invention was made" (App. 26a).

CONCLUSION.

We submit that the petition for a writ of *certiorari* should be denied.

Respectfully submitted,

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REPLY BRIEF FOR PETITIONER

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REPLY BRIEF FOR PETITIONER

Respondent's brief says that Petitioner's statement of the question presented misstates the holding of the Court below in respect to holding "the patents*" invalid on a technical point of Patent Office practice.

Respondent does not otherwise challenge the content of the question presented by Petitioner. Thus, the context of the question as to whether the constitutional purpose of the patent laws was subverted, is conceded. There *was* a declaratory judgment action brought by an old established company in an industry, against the patent of a new and infant competitor. The Court below *did* vitiate the patent on its face on a point which had already been considered and waived by the Patent Office before issuing the patent. The Court below *did not* weigh the worth of the invention actually

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* The question presented refers only to Wilcox apparatus patent 3,026,098 which was the subject of the declaratory judgment action.

claimed in the new competitor's patent, as to its lack of obviousness or anticipation or its commercial success. There *was* uncontroverted evidence that the invention had made possible the creation of a new industrial enterprise in an economically depressed region of the United States.

In the *Schriber* case cited by Respondent, this Court first identified the invention (webs "laterally flexible") and then ascertained that it was not disclosed in the specification. Again, in the *Permutit* case, this Court first identified the invention ("free" bed of zeolite) and then ascertained that it was neither disclosed nor claimed. In the present case, the Court of Appeals did not even concern itself with the threshold question of identifying the Wilcox invention as claimed.

We respectfully submit that the protection intended by the Constitution was denied to a really great invention in the notoriously backward coal mining industry, and solely on a technical point of Patent Office practice which had already been considered and waived by the Patent Office.

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